

REMARKS

Claim 2 has been amended to correct a grammatical error.

Rejections Under 35 U.S.C. § 103

Claims 1-28 stand rejected under 103(a) as unpatentable over Kotzin, US Patent 4,689,848 in view of Schuring, US Patent 5,143,500. Applicants respectfully disagree.

Obviousness requires some suggestion or motivation to combine the references. One skilled in the art would not be motivated to combine Schuring with Kotzin. The axle 48 in Kotzin is press fit into the bosses 40 so as to be "secured against rotation." (Col. 3, lines 23-25). Because the axle is secured against rotation, there would be no motivation to combine the design of Kotzin with a fastener that permits rotation. A proposed modification cannot change the principle of operation of the reference (MPEP 2143.01). Combining the rotatable fastener of Schuring with the rigidly secured axle of Kotzin would change the principle of operation of the axle in Kotzin.

Additionally, Kotzin teaches that the axle 48 is made of steel or other material stronger than plastic, since plastic materials tend to "creep" if subjected to significant stresses over a prolonged period. (Col. 3, line 64 to Col. 4 line 1). Thus, Kotzin teaches against using a plastic axle. Schuring discloses a plastic fastener system that may be adapted to secure the shaft of a roller for a closet door track system. (Col. 2, lines 13-15, 48-49). Schuring does not disclose or suggest using a material other than plastic, and because the parts 42 must flex (Col. 3, lines 64-65), Schuring teaches away from using steel, since steel would lack suitable flexibility. Because Kotzin teaches a steel axle and teaches away from a plastic axle, and Schuring teaches a plastic fastener, one skilled in the art would not be motivated to combine the two references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Because one skilled in the art would not be motivated to combine Schuring with Kotzin, claims 1-28 are not obvious. Applicants respectfully request that the rejections be withdrawn.

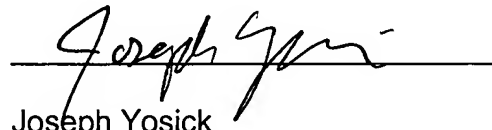
Obviousness also requires that the prior art references teach or suggest all the claim limitations. Claim 11 requires a first housing comprising a first top portion having a first pin opening and a second housing comprising a second top portion having a second pin opening, wherein the pivot pin passes through the first and second pin openings. Kotzin discloses a first and second housing 12 and 13, with a shaft 28 passing through a bore 24 in only one housing 12. (Col. 2, lines 64-66; Figures 3 and 4). Thus, Kotzin does not disclose two housing pieces, each with an opening that a pivot pin passes through. Additionally, the housing of Kotzin includes holes 60 and projections 62 that serve as fasteners to secure members 12 and 13 to one another. (Col. 3, lines 51-53). The pivot pin of the claimed invention may be used to help hold the first and second housings together, thus eliminating the need for structures such as the projections 62 and holes 60 required by the caster in Kotzin. Omission of an element with the retention of an element's function is an indicia of unobviousness. (MPEP 2144.04). The invention of claim 11 eliminates the projections 62 and holes 60 required by the caster in Kotzin, while retaining their function of holding the two housing portions together. Thus, claim 11, and claims 12-20 depending therefrom, are not obvious. Applicants respectfully request that the rejections be withdrawn.

Claims 25-28 also require that the pivot pin goes through a first pin opening and a second pin opening, and thus are not obvious for the same reasons as described above for claim 11. Applicants respectfully request that the rejections be withdrawn.

SUMMARY

Applicants believe the present application is now in condition for allowance. If the Examiner has any remaining issues, he is invited to contact the undersigned attorneys for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Joseph Yosick", is written over a horizontal line.

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